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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,663	12/17/2004	Hitoshi Asahi	52433/782	7855
26646	7590	06/19/2007	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			YEE, DEBORAH	
		ART UNIT	PAPER NUMBER	
		1742		
		MAIL DATE	DELIVERY MODE	
		06/19/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/518,663	ASAHI ET AL.	
	Examiner Deborah Yee	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
  - 4a) Of the above claim(s) 6, 8 and 10 to 16 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 to 5, 7 and 9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10-16-06; 12-17-04</u> .                                      | 6) <input type="checkbox"/> Other: _____.                         |

**DETAILED ACTION*****Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 to 5,7 and 9, drawn to steel tube.

Group II, claim(s) 6,8 and 10 to 16, drawn to welded steel tube wherein the welded part is normalized or quenched and tempered and its process of making.

2. The inventions listed as Groups of group I and group II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common technique feature that groups I and II share is the composition of claim 1. This composition does not provide a contribution over the prior art in view of US Patent 7,225,868 (hereinafter ARAI) or US Patent 4,772,771 (hereinafter MURAYAMA).

2. During a telephone conversation with Mr. John Kelly on May 16, 2007 a provisional election was made with traverse to prosecute the invention of group I, claims 1 to 5, 7 and 9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6, 8, and 10 to 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1 to 5, 7 and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by US Patent 7,225,868 (hereinafter ARAI).

6. Steel C of ARAI in table 1 of column 12 and table 2 of columns 13-14 meets the claimed composition and has a C1/C0 equivalent to the claimed a/b within the range of 0.85 to less than 1.0. See lines 25 to 39 in column 12 wherein C1=collapse strength after expanding 10-20% and C0=collapse strength without expanding.

7. Even though ARAI does not teach ratio c/d in the range of 1 to 1.2 as recited by claims 3 and 4 wherein c= collapse strength after expansion 10 to 20% and ageing at 80 to 200C and d=collapse strength of unexpanded steel pipe, such property would be expected since composition and a/b is met and in absence of proof to the contrary.

8. With regard to claims 7 and 9, ARAI teaches a steel pipe for oil wells having excellent collapse strength after expansion and is characterized as being used expanded in an oil well drilled into the ground. Even though a fluid of 80 to 200C

circulated through the well after expansion as recited by claim 9 is not taught, such temperature would be expected when excavating oil.

9. Claims 1 to 5, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,772,771 (hereinafter MURAYAMA) cited by applicant in IDS dated 10-16-06 in view US Patent 7,225,868 (hereinafter ARAI)

10. MURAYAMA in table 1 of columns 3-4 discloses specific steel pipe alloy examples having compositions that meet the recited claims. Even though 0.001 to 0.01% N as recited by the claims is not disclosed by prior art, such would not be a patentable distinction. Note that ARAI on lines 44 to 51 in column 10 teaches N in an analogous oil well steel pipe alloy as an inevitable impurity present in amounts of up to 0.01%. Hence one skilled in the art would expect MURAYAMA steel to, also, contain up to 0.01% N. Moreover ARAI on lines 24 to 28 in column 11 teaches that it is desirable for steel to contain suitable amounts of Ti and N to form TiN for improving ductility and prevent coarsening of grains. Since such properties are sought by MURAYAMA, then it would be an obvious modification for one skilled in the art to have Ti and N present in the steel.

11. Even though MURAYAMA does not teach the ratio a/b range of 0.85 to <1.0 or the ratio c/d range of 1 to 1.2 as recited by the claims, such properties would be expected since the composition and process of making comprising the steps of hot rolling and coiling below 300C are closely met, and in absence of proof to the contrary.

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Last 2 lines of claims 3 and 4 recite, "...steel pipe measured for a..." yet there is no antecedent basis for "a".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on monday-friday 6:00am-2: 30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Deborah Yee  
Primary Examiner  
Art Unit 1742

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